REMARKS/ARGUMENTS

The foregoing amendment and the following arguments are provided to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

35 U.S.C. § 102(e) Rejections

Examiner rejected claims 17 and 19 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 5,999,997 (hereinafter "Pipes").

35 U.S.C. § 103(a) Rejections

Examiner rejected claims 1-5, 7-9, 12, 14, and 18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,999,997 (hereinafter "Pipes"). In view of U.S. Patent 6,523,079 (hereinafter "Kikinis").

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (Manual of Patent Examining Procedure (MPEP) ¶ 2143.03).

Applicant's independent claims 1, 12, and 17, include limitations that are not disclosed nor suggested by the Pipes nor Kikinis. As a result, Applicant's independent claims are patentable over Pipes in view of Kikinis.

In particular, Applicant's independent claims 1, 12, and 17, include the limitation, or a limitation similar thereto, <u>of a first operating system on the core</u>

computer and a second operating system on the notebook computer, *the first operating system on the core computer being smaller in size and having less functionality than the second operating system.*

In the recent office action, the examiner indicated that Kikinis teaches a PDA with an operation system (BIOS chip) smaller in sized and provides less functionality than the operation system of the host computer. Applicant respectfully disagrees with the examiner. The BIOS chip disclosed in Kikinis does not disclose nor suggest applicant's claimed first operating system which is smaller in size and has less functionality than the second operating system.

In particular, an operating system is understood by those skilled in the art to include the master control program that runs the computer. The operating system sets the standards for all application programs that run in the computer. The applications "talk to" the operating system for all user interface and file management operations. The operating system typically performs functions including user interface management, job management, task management, data management, and device management, among other tasks.

A BIOS, however, is understood by those skilled in the art to include set of routines in a computer, which are stored on a chip and provides an interface *between the operating system and the hardware*. The BIOS supports the peripheral technologies and internal services such as the realtime clock (time and date). On startup, the BIOS tests the system and prepares the computer for operation by querying its own small CMOS memory bank for drive and other configuration settings. The BIOS then loads the

operating system and passes control to it. The BIOS accepts requests from the drivers as well as the application programs.

As a result, the BIOS and the operating system are clearly two separate features in a computer, and the BIOS is not to be equated to the operating system. Moreover, Kikinis, defines the BIOS as disclosed in Kikinis as:

> Embedded in ROM in a compressed fashion, along with an uncompressed portion for testing and initializing system memory on start-up, and an uncompressed compression utility routine configured for decompressing the compressed BIOS portion. (col. 3, lines 24-28).
>
> . . .
>
> Compressed BIOS
>
> . . . A compressed BIOS system is described below for just this purpose, wherein a BIOS code routine is stored in a compressed portion of a ROM along *with an uncompressed portion configured for testing and initializing system memory on startup, and an uncompressed portion comprising a decompression utility configured to decompress the compressed ROM portion.* (emphasis added). (col. 19, lines 30-40).
>
> . . .
>
> There are three different portions of the [BIOS]. Portion 1013 is code to perform all operations to initialize and test the system RAM4, and make it ready for use, and is a familiar portion of conventional BIOS routines. This portion in some applications needs to perform such functions as initializing and testing a memory controller and cache controllers and cache memory. Portion 1015 is a decompression utility. Portion 1017 represents the balance of the BIOS code in compressed form. It will be apparent to those with skill in the art that there are a number of compression schemes and related decompression routines that might be used. (col. 20, lines 7 -19).

As a result, the BIOS disclosed in Kikinis does not disclose nor suggest applicant's first operating system which is smaller in size and has less functionality than the second operating system. Therefore, applicant's independent claims 1, 12, and 17, include limitations that are not disclosed nor suggested by the Pipes nor Kikinis, and independent claims are patentable over Pipes in view of Kikinis.

Applicant's remaining claims depend from at least one of the independent claims discussed above, and therefore include the distinguishing claim limitations as discussed above. As a result, Applicant's remaining claims are also patentable.

CONCLUSION

Applicant respectfully submits the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call John Ward at (408) 720-8300, x237.
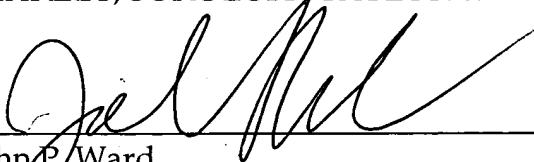
Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: 9/9/03

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